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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/409,680	09/30/1999	MASATOSHI NAKANISHI	0234-0372P	5737

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EXAMINER
CHEA, THORL

ART UNIT	PAPER NUMBER
1752	20

DATE MAILED: 06/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Offic Action Summary	Application No. 09/409,680	Applicant(s) NAKANISHI ET AL.	
	Examin r Thorl Chea	Art Unit 1752	

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 April 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13,17-32 and 35-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1-6,31,32 and 35* is/are allowed.

6)☒ Claim(s) *7-13,17-22,24-29,36 and 37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 7-13, 17-22, 24-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The antecedent basis "solid fine-grains" is not consisitent with the "fine grains" previously stated. Thus, the antecedent basis for "solid fine-grains" is unclear. See claims 7, 17, 24 last line.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 7-12, 17-21, 24-28, 35-37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Scaringe

et al (Scaringe). Note to Scaringe in column 4 lines 58-67 to column 5, lines 1-7 wherein the solid particle have an average size of 0.05 to 10 μm and the amount of additive in the range of 0.05 % to 50 %. The solid particle taught in Scaringe encompasses the size of 0.01 to 1 μm and the percentage of the additive used in the present claimed invention. Therefore, the range as claimed is either anticipated by or alternatively obvious over the size range and the amount of additive taught in Scaringe. Moreover, the invention as claimed is related to the claiming of a product by a process.

"E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior art product was made by different process. *In re Thorpe* 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985).

6. Claims 13, 22, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scaringe et al as applied to claims 7-12, 17-21, 24-28, 35-37 above, and further in view of Lobo et al (Lobo).

Lobo discloses the use of an ionic polymer within the scope of the claimed invention to create a small particle photographic dispersion of PUMs without increasing the level of surface active material or hydrophilic colloid, without increasing the homogenizing temperature and without the use of auxiliary solvent. Note to the problem to be solved in column 4, lines 10-15, and the polymer in columns 11-12. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the

polymer taught in Lobo in the process for preparing a solid fine particle taught in the '333 patent or '05 patent for same reason taught in Lobo, and thereby provide a material as claimed.

7. Claims 1-6 and 31-32 are allowed over the prior art of record.

Response to Arguments

8. Applicant's arguments filed April 16, 2003 have been fully considered but they are not persuasive. The argument with respect to the rejection under 35 USC 112, second paragraph is not persuasive since the claims has not been amended to remove or add such language. Note for instance the language in claim 7, the language "fine grains" in line 8, 16 and solid fine grains in lines 19, 20. See similar languages in claims 17, 24.

The applicants further argue than claims 7, 17 and 24 is allowable due to incorporation of claim 34 that was allowed in the previous office action. The argument is not persuasive. The indication of claim 34 as allowable stated in the previous office action was over sighed, and it should have been rejected along with rejected claim 7. The use of dispersing agent in the process is taught in Scaringe et al in column 6 lines 28-40, and this surfactant is an intermediate product. It would be removed after processing, and it fails to differentiate the claimed particle from that taught in the applied prior art of record.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tch
June 23, 2003

Thorl Chea
Primary Examiner
Art Unit 1752